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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,711	08/05/2003	William F. McKay	4002-3365	8938
52196	7590	03/17/2006		
KRIEG DEVAULT LLP ONE INDIANA SQUARE, SUITE 2800 INDIANAPOLIS, IN 46204-2709			EXAMINER SNOW, BRUCE EDWARD	
			ART UNIT 3738	PAPER NUMBER

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/634,711	<b>Applicant(s)</b> MCKAY, WILLIAM F.	
	<b>Examiner</b> Bruce E. Snow	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 30 and 32-67 is/are pending in the application.
- 4a) Of the above claim(s) 3-8, 14, 34, 35, 39-41, 48-54, 64 and 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 9-11, 13, 30, 32, 33, 36-38, 42, 44, 45, 55-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/27/06</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 1/27/06 have been fully considered.

The objection to the specification for failing to provide proper antecedent basis for the claimed subject matter "dumbbell" has been withdrawn; applicant has removed this term from all claims.

Applicant's amendments and arguments overcame the rejection of under 35 U.S.C. 102(b) as being anticipated by Grosse et al (WO 97/23174).

Applicant's arguments overcame the rejection of under 35 U.S.C. 102(b) as being anticipated by Brosnahan, III (5,645,598).

Regarding the rejection under 35 U.S.C. 103(a) as being unpatentable over Ulrich (DE 19630256) in view of Michelson (6,123,705), it is applicant's position that they have a priority date prior to the Ulrich reference which is not persuasive. All claims are directed to the elected species shown in figure 37. This subject matter was originally present in PCT/US98/26254 having a filing date of 12/10/98 which is the priority date for all claims. Ulrich has a publication date of 1/29/98 which is earlier and is proper prior art.

MPEP 715.02(I) state:

**SWEARING BEHIND ONE OF A PLURALITY OF COMBINED REFERENCES**  
Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. However, as discussed above, applicant's 37 CFR 1.131 affidavit must show possession of either the whole invention as claimed or something falling within the claim(s) prior to the effective date of the reference being antedated; it is not enough merely to show possession of what the reference happens to show if the reference does not teach the basic inventive concept.

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Where a claim has been rejected under 35 U.S.C. 103 based on Reference A in view of Reference B, with the effective date of secondary Reference B being earlier than that of Reference A, the applicant can rely on the teachings of Reference B to show that the differences between what is shown in his or her 37 CFR 1.131 affidavit or declaration and the claimed invention would have been obvious to one of ordinary skill in the art prior

to the date of Reference A. However, the 37 CFR 1.131 affidavit or declaration must still establish possession of the claimed invention, not just what Reference A shows, if Reference A does not teach the basic inventive concept.

### ***Allowable Subject Matter***

Claims 43, 66, 67 are allowed.

Claims 12, 46, 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 9-11, 13, 30, 32, 33, 36-38, 42, 44, 45, 55-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich (DE 19630256) in view of Michelson (6,123,705).

Ulrich teaches a first cylindrical fusion device being dumbbell shaped including a opposing end pieces 17, 18 and a central element 19 connecting said opposing end pieces. However, Ulrich fails to teach nesting a second dumbbell fusion device with the

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first. Michelson also teaches cylindrical fusion devices which are nested together by utilizing a cutout region; see at least figure 25, elements 406, 408; and figure 43, concave cutout region 902. It would have been obvious to one having ordinary skill in the art to have utilized the teachings of Michelson of nesting two fusion device together with the fusion devices of Ulrich because *“two cylindrical implant considered to be the preferred number as it is a much more stable construct and has more surface area than a single implant placed centrally (column 2, lines 18-20)”* and to include a cutout region *“when it is desirable to insert two implants side-by-side into cylindrically prepared channels, and where the height of the disc space between two adjacent vertebra is so great relative to the transverse width of the spine”* such that two implant fit within the transverse width (column 3, lines 40 et seq.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**BRUCE SNOW**  
**PRIMARY EXAMINER**